

**UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

VELVAC, INC.,

Plaintiff,

v.

RETRAC MIRRORS, AND
LUVERNE TRUCK EQUIPMENT, INC.

Defendants.

Case No. 1:14cv6371

JURY TRIAL DEMANDED

COMPLAINT

Plaintiff Velvac, Inc. (“Volvac”) files this Complaint against defendants Retrac Mirrors (“Retrac Mirrors”) and Luverne Truck Equipment, Inc. (“Luverne Truck Equipment”) and alleges as follows:

NATURE OF THE ACTION

1. This is an action for patent infringement arising under the patent laws of the United States, 35 U.S.C. §§ 1 *et seq.*

2. This is also an action for trade dress infringement under 15 U.S.C. § 1125(a) (otherwise known as § 43(a) of the Lanham Act), trade dress dilution under 15 U.S.C. § 1125(a) (otherwise known as § 43(c) of the Lanham Act), unjust enrichment, and unfair competition.

THE PARTIES

3. Plaintiff Velvac is a corporation organized and existing under the laws of the State of Delaware, with its principal place of business at 2405 S. Calhoun Road, New Berlin, WI 53151-2709.

4. On information and belief, defendant Luverne Truck Equipment is a corporation organized under the laws of the State of Minnesota with a principal place of business at 1200 E. Birch Street, Brandon, SD, 57005.

5. Public documents list Retractable Mirrors as a division of Luverne Truck Equipment. Retractable Mirrors has a principal place of business at 1200 E. Birch Street, Brandon, SD, 57005. Retractable Mirrors is a manufacturer and supplier of both OEM and Aftermarket high quality mirrors for the trucking industry. On information and belief, Retractable Mirrors was established by Luverne Truck Equipment to design and manufacture exterior mounted mirrors.

6. Retractable Mirrors and Luverne Truck Equipment manufacture and distribute exterior mounted mirrors for truck OEM and aftermarket mirrors for light, medium, and heavy-duty trucks, buses, vans, pickups and specialized truck vehicles, including the military. LUVERNE TRUCK EQUIPMENT, ABOUT US, http://www.luvernetruck.com/About_LTE/about_lte.html (last visited August 7, 2014); RETRACTABLE MIRRORS, www.retractablemirrors.com (last visited August 7, 2014). Retractable Mirrors is involved in the entire production process from initial design concepts through prototypes and continuing into fabrication and customer support. OUR ENGINEERING DEPARTMENT, http://www.retractablemirrors.com/About_Retractable/About_4/about_4.html (last visited, August 7, 2014). Retractable Mirrors manufactures, uses, offers for sale, and sells the Retractable

“sailmount” mirror, which has been offered for sale and sold within the United States and, in particular, this District.

7. In addition to offering for sale in the United States, Retrac Mirrors and Luverne Truck Equipment have displayed the Retrac “sailmount” mirror as early as March 27, 2014 at the 2014 Mid-America Trucking Show held in Louisville, Kentucky. The Mid-America Trucking Show is the largest annual heavy-duty trucking industry event in the world and held each year at the Kentucky Expo Center in Louisville, Kentucky. MID-AMERICA TRUCKING SHOW, <http://www.truckingshow.com/> (last visited, August 7, 2014). The Mid-America trucking show is attended by people from all around the United States and attracts more than 70,000 attendees from throughout the United States and abroad. *Id.*

JURISDICTION AND VENUE

8. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331 and 1338.

9. This Court has personal jurisdiction over Retrac Mirrors and Luverne Truck Equipment at least by virtue of Retrac Mirrors and Luverne Truck Equipment having conducted business in this District and/or having committed one or more acts of patent and trade dress infringement in this District. Retrac Mirrors sells its products and does business in the state of Illinois through, William Shimp Sales, Inc., which is listed on Retrac Mirrors’ website as the sales representative of Illinois. REPRESENTATIVE LOCATION MAP, <http://www.retracmirrors.com/Representatives/representatives.html> (last visited, August 14, 2014). Moreover, Luverne Truck Equipment lists eleven businesses in Illinois that carry Luverne Truck Equipment accessories, presumably including Retrac Mirrors. Thus, Retrac Mirrors and

Luverne Truck Equipment have purposefully availed itself of the benefits of Illinois and this District.

10. Venue is proper under 28 U.S.C. §§ 1391 and 1400 because Retrac Mirrors and Luverne Truck Equipment have regularly conducted business in this District and have committed, and is continuing to commit acts of patent infringement and trade dress infringement and dilution in this District by making, using, selling, or offering to sell truck mirrors that infringe Velvac's patents and Velvac's trade dress.

FACTUAL BACKGROUND

11. Velvac is a market leader in providing exterior mirrors and vision systems for a wide range of medium and heavy duty vehicles. Velvac has made significant innovations in this market with its unique and innovative styling, performance, and features of mirror systems. This has resulted in a high degree of market success with OEMs and body builders using a class of mirrors known as the 2020XG mirror. Accordingly, Velvac has also actively pursued intellectual property protection for its 2020XG mirror, including having obtained U.S. Patent No.7,452,088 B2 and having patent pending features of the 2020XG mirror, including four pending design patent applications.

12. Since as early as 2007, Velvac has designed, manufactured, and sold in interstate commerce the Velvac 2020XG mirror. Velvac has sold millions of dollars of products featuring this design and has promoted these design features extensively. As such, Velvac's mirrors are very well known and very highly regarded among consumers throughout North America and are immediately recognized as unique to Velvac and as indicators of the source and quality of Velvac products.

13. Velvac has made significant financial investment in the design, tooling, and validation of the 2020XG truck mirrors, including hiring a product development firm, Brooks Stevens, Inc., to design the 2020XG mirror. Velvac has also expended substantial time, effort, and money in advertising, promoting and marketing Velvac's 2020XG mirror throughout North America. For example, Velvac promotes its 2020XG mirror via its website, and in catalogs, brochures, in advertisements, through prominent display and promotion at 6 - 8 trade shows per year, and through other promotional material items sent to customers throughout North America. Moreover, large national OEM customers such as Ford, General Motors, Winnebago, Fleetwood RV, Thor Motorized, Forest River, Budget Rental Trucks, Penske Rental Trucks, and others have made the 2020XG mirror available as either standard equipment or a factory option on various vehicle models they offer. The Velvac mirror is called out by name and described as an available accessory for the 2014 Chevrolet Express 4500 Cutaway Standard and the 2014 Chevrolet Express 3500 Cutaway Standard. 2014 CHEVROLET EXPRESS 4500 CUT-AWAY STANDARD & OPTIONAL EQUIPMENT, <http://www.gmfleet.com/chevrolet/express-4500-cutaway-van/features-specs/standard-optional-equipment.html> (August 14, 2014). Many photos of the new 2015 F-650 and F-750 on Ford's website have also included images at various angles showcasing the design of the 2020XG mirrors. FORD F650-F750 GALLERY, <http://www.ford.com/commercial-trucks/f650-f750/gallery/photos/> (August 7, 2014). Velvac's sales of its 2020XG mirrors throughout the United States have been substantial, as measured by geographic scope, unit sales, and/or dollar sales.

14. Velvac owns valuable trade dress rights in the design of the 2020XG mirror. Velvac has also used and promoted the 2020XG mirror in connection with its business since at least 2007, resulting in extensive, valuable goodwill and widespread recognition in its design

throughout the North America as identifying Velvac, or at least a single anonymous source. Velvac's trade dress is inherently distinctive, is extremely well-known, and is widely and immediately recognized by shuttle-bus builders, rental truck builders, RV builders, truck body builders, medium duty truck OEMs, and consumers of such vehicles and parts in the aftermarket in the United States, as an indication of the source and quality of the 2020XG mirrors.

15. As a result of its distinctiveness, its extensive use and promotion, and its widespread recognition, the 2020XG trade dress carries substantial and valuable goodwill, which belongs exclusively to Velvac.

16. Velvac's 2020XG mirror includes unique, arbitrary, and non-functional characteristics, such as the use of a grooved cylindrically shaped arm that horizontally connects the mirror to the base, the arm and mirror had have a unique and distinctive shape, including a ridge behind the mirror head, the base has a distinctive aesthetically pleasing design.

17. Retrac Mirrors and Luverne Truck Equipment have infringed upon, and diluted the distinctive nature of Velvac's trade dress by designing and manufacturing the Retrac "sailmount" mirror with a design that is strikingly similar to that of Velvac's 2020XG mirror.

18. Chart 1 below demonstrates Retrac Mirrors and Luverne Truck Equipment's trade dress infringement by comparing images of Velvac's 2020XG mirror with Retrac "sailmount" mirror. Attached as Exhibit B are PowerPoint slides containing additional photos and angles comparing Velvac's 2020XG mirror with Retrac "sailmount" mirror side-by-side.

Velvac's 2020XG Mirror	Retrac "sailmount" mirror
	
	
	

Velvac's 2020XG Mirror	Retrac "sailmount" mirror
	
	

Velvac's 2020XG Mirror	Retrac "sailmount" mirror
	

19. The design, appearance, and configuration of Retrac Mirrors' "sailmount" mirror is confusingly similar to the design, appearance, and configuration of Velvac's 2020XG mirror, including Velvac's trade dress. For example, the scheme, designs, and overall appearance of Velvac's 2020XG mirror is virtually identical to the Retrac Mirrors' "sailmount," including:

- Retrac Mirrors' "sailmount" mirror uses the exact same exterior mirror design appearance with an arm attachment that connects directly into the side of the mirror housing resulting in the exact same ridged design and indentation on the mirror.
- Both of the mirror heads have the same exact shape and design features.

- The inside arm of both mirrors have a trapezoidal indentation that is exactly similar in size, and shape. Both of the trapezoidal indentations are positioned in the exact same location and have similar depressed angles in their indentations.
- The shapes and size of the base of the two mirrors have exactly the same appearance. Each of the bases has the same grooved and rounded structure which connects the mirrors to the vehicle.

20. Luverne Truck Equipment's website states that Retrac Mirrors is a division of Luverne Truck Equipment. Accordingly, Retrac Mirrors' website states that "Retrac's hands-on engineering team works from initial design concepts through prototypes and continuing into fabrication and customer supports. Being involved in the entire production process ensures the greatest success within our manufacturing endeavors." RETRAC MIRRORS – OUR ENGINEERING DEPARTMENT, http://www.retracmirrors.com/About_Retrac/About_4/about_4.html (August 7, 2014).

21. Retrac Mirrors and Luverne Truck Equipment's unauthorized use of Velvac's 2020XG mirror trade dress is likely to deceive or confuse consumers, particularly aftermarket consumers, into thinking that the Retrac "sailmount" mirror is a Velvac product or come from the same source, and is likely to create the false impression among consumers that its products are approved by or affiliated with Velvac.

22. The Retrac "sailmount" mirror is so similar to Velvac's 2020XG mirror that it is likely to create, in consumers' minds, an association with Velvac that diminishes and impairs the distinctiveness of Velvac's trade dress. For example, the color scheme, design, and overall

appearance of the Retractable “sailmount” mirror is virtually identical to that of Velvac’s 2020XG mirror.

23. Velvac’s trade dress, taken as a whole, is not functional, but are aesthetic features. Exterior mounted mirrors can be and are designed in any number of ways, with different designs, colors, and shapes. Velvac’s trade dress incorporates creative design features that are not related to the function of an exterior mounted mirror.

24. The design of the Retractable “sailmount” mirror clearly was copied from Velvac’s 2020XG mirror. On information and belief, the Retractable “sailmount” mirror was created with full knowledge of Velvac’s rights, and with the intent to create confusion, mistake, and deception among the consuming public and to create an association in consumer’s minds with Velvac’s 2020XG design. Retractable Mirrors and Luverne Truck Equipment deliberately adopted Velvac’s trade dress knowing and intending that the relevant public, including consumers, would likely be confused, mistaking the Retractable “sailmount” mirror for Velvac’s, thereby unfairly diverting sales from Velvac to Retractable Mirrors and Luverne Truck Equipment. At the very least, the relevant public, including consumers, would mistakenly believe there to be an association, connection, and/or affiliation between Velvac and Retractable Mirrors and/or their respective products.

COUNT I – INFRINGEMENT OF THE ’088 PATENT

25. Paragraphs 1 through 24 are incorporated by reference as though fully stated herein.

26. United States Patent No. 7,452,088 B2 (“the ’088 patent”), titled “Mirror with Adjustable Detent,” (Exhibit A) was issued on November 18, 2008, based on an application filed

on March 6, 2007. Velvac is the sole owner of the entire right, title, and interest in the '088 patent, including the right to recover for past, present, and future infringement and violations thereof.

27. Velvac alleges that Retrac Mirrors and Luverne Truck Equipment have made, used, offered to sell, and/or sold within the United States, the Retrac “sailmount” mirror that infringe at least one of the claims of the '088 patent, literally and/or under the doctrine of equivalents, in violation of Velvac’s statutory rights.

28. Retrac Mirror and Luverne Truck Equipment’s infringement have damaged and continues to damage and injure Velvac. The injury to Velvac is irreparable and will continue unless and until Retrac Mirrors and Luverne Truck Equipment are enjoined from further infringement.

29. Retrac Mirrors and Luverne Truck Equipment have engaged and is engaging in willful and deliberate infringement of the '088 patent. Such willful and deliberate infringement justifies an increase of three times the damages to be assessed pursuant to 35 U.S.C. § 284 and further qualifies this action as an exceptional case supporting an award of reasonable attorneys’ fees pursuant to 35 U.S.C. § 285.

COUNT II – TRADE DRESS INFRINGEMENT

30. Velvac incorporates by reference each of the preceding allegations of paragraphs 1-29 above as though stated herein.

31. Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), provides in pertinent part that “[a]ny person who, on or in connection with any goods or services, or any container for

goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . . is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person. . . shall be liable in a civil action. . .”

32. Retractable Mirrors and Luverne Truck Equipment have used and is using trade dress for its Retractable “sailmount” mirror that is likely to cause confusion, to cause mistake, or to deceive as to the affiliation, connection, or association of Retractable Mirrors and Luverne Truck Equipment with Velvac, or as to the origin, sponsorship, or approval of Retractable Mirrors and Luverne Truck Equipment’s goods, services, or commercial activities, all within the meaning of Section 43(a) of the Lanham Act. These actions by Retractable Mirrors and Luverne Truck Equipment are likely to influence consumers’ purchasing decisions. Retractable Mirrors and Luverne Truck Equipment’s copying of Velvac’s trade dress is an intentional attempt to pass off Retractable “sailmount” mirror as Velvac products. Retractable Mirrors and Luverne Truck Equipment’s aforesaid acts constitute willful infringement of Velvac’s trade dress rights in its 2020XG mirror, in violation of 15 U.S.C. § 1125(a)(1).

33. Retractable Mirrors and Luverne Truck Equipment’s activities have damaged Velvac and, unless enjoined, will continue to cause irreparable damage and injury to Velvac and the public. Velvac lacks an adequate remedy at law.

COUNT III – TRADE DRESS DILUTION

34. Velvac incorporates by reference each of the preceding allegations of paragraphs 1-33 above as though stated herein.

35. Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), provides remedies to “the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness,” against “another person who, at any time after the owner’s mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.”

36. Velvac’s 2020XG trade dress is famous within the meaning of Section 43(c) of the Lanham Act, and it became famous before Retrac Mirrors and Luverne Truck Equipment began using the design referred to in this complaint.

37. Retrac Mirrors and Luverne Truck Equipment’s use of the design for the Retrac “sailmount” mirror has caused and is likely to cause dilution by blurring of Velvac’s 2020XG trade dress, in violation of Section 43(c) of the Lanham Act.

38. Retrac Mirrors and Luverne Truck Equipment’s activities have damaged Velvac and, unless enjoined, will continue to cause irreparable damage to Velvac. Velvac lacks an adequate remedy at law.

COUNT IV – UNJUST ENRICHMENT

39. Velvac incorporates by reference each of the preceding allegations of paragraphs 1-38 above as though stated herein.

40. Retrac Mirrors and Luverne Truck Equipment have benefitted from its wrongful and unauthorized use of Velvac's trade dress, reputation, and good will, and have not paid any compensation to Velvac in return for those benefits.

41. Retrac Mirrors and Luverne Truck Equipment's retention of those benefits violates the fundamental principles of justice, equity, and good conscience.

42. Retrac Mirrors and Luverne Truck Equipment's failure to compensate Velvac constitutes unjust enrichment.

43. Retrac Mirrors and Luverne Truck Equipment's activities have caused and, unless enjoined, will continue to cause irreparable damage to Velvac. Velvac lacks an adequate remedy at law.

COUNT V – UNFAIR COMPETITION

44. Velvac incorporates by reference each of the preceding allegations of paragraphs 1-43 above as though stated herein.

45. Retrac Mirrors and Luverne Truck Equipment's constitute unfair competition in violation of the Lanham Act, 15 U.S.C. §1125(a) and the common law of various states, including without limitation the States of Illinois, Kentucky and Wisconsin.

PRAYER FOR RELIEF

WHEREFORE, Velvac requests that judgment be granted in its favor and against Retrac Mirrors and this Court award it the following relief:

(a) Judgment that Retractable Mirrors and Luverne Truck Equipment have infringed the '088 patent;

(b) Judgment that Retractable Mirrors and Luverne Truck Equipment's infringement was willful and issue an Order requiring Retractable Mirrors to pay enhanced damages pursuant to 35 U.S.C. § 284;

(c) Injunction enjoining Retractable Mirrors and Luverne Truck Equipment, its officers, directors, servants, managers, employees, agents, attorneys, successors and assignees, and all persons in active concert or participation with any of them, from further acts of infringement of the '088 patent, pursuant to 35 U.S.C. § 283;

(d) Injunction prohibiting Retractable Mirrors and Luverne Truck Equipment, and anyone in active concert or participation with Retractable Mirrors and Luverne Truck Equipment, from continued infringement of Velvac's trade dress, from continued dilution of Velvac's trade dress, and from continued acts leading to unjust enrichment and unfair competition.

(e) An order requiring Retractable Mirrors and Luverne Truck Equipment, and anyone in active concert or participation with Retractable Mirrors and Luverne Truck Equipment, to recall all infringing products from the market and to destroy all Retractable "sailmount" mirrors, including all merchandise, prototypes, molds, displays advertisements, brochures, order forms, price lists, catalogs and any other materials, whether in paper or electronic form, in its possession or control that bear Velvac's 2020XG trade dress, and provide certification of such destruction;

(f) An award of money damages adequate to compensate for the damages caused by Retractable Mirrors and Luverne Truck Equipment's unlawful acts;

(g) An award that trebles the amount of actual damages assessed against Retrac Mirrors and Luverne Truck Equipment and in favor of Velvac;

(h) An award of Retrac Mirrors and Luverne Truck Equipment's profits attributable to the infringements, increased by an amount the Court finds to be just.

(i) An award of the amount by which Retrac Mirrors and Luverne Truck Equipment has been unjustly enriched or the value of the benefit received by Retrac Mirrors and Luverne Truck Equipment from its unlawful acts;

(j) An award to Velvac of its reasonable attorneys' fees and costs;

(d) Adjudge and decree this case exceptional under 35 U.S.C. § 285 and award Velvac its reasonable attorneys' fees, expenses, and costs incurred in prosecuting this action; and

(e) Such other and further relief as the Court deems just and proper.

DEMAND FOR JURY TRIAL

Velvac hereby demands a trial by jury on all issues as to which jury trial by jury is appropriate.

Dated: August 18, 2014

Respectfully submitted,

By: /s/ Sailesh K. Patel

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